REMARKS

Claims 1-30 and 35-39 were pending in the application as examined, although claims 18-21 were withdrawn as being directed to a non-elected invention. In the Office Action, claims 35-39 were rejected under 35 USC § 112; claims 1-16 and 23-29 were rejected under 35 USC § 102(a) as being anticipated by Blackwell *et al.* and/or by Clemons *et al.*; claims 23-29 were rejected under 35 USC § 103(a) as being obvious over either of the same two references. The Office Action indicated that claims 17 and 22 were allowable if rewritten in independent form.

The Amendment to the Claims included here cancels claims 35-39, thereby rendering the rejection under 35 USC § 112 moot.

The Amendment to the Claims also rewrites claims 17 and 22 in independent form, such that they are allowable.

The only outstanding rejections, therefore, are art rejections. Both of the relevant references were published less than a year prior to the filing of the provisional application to which the present application claims priority, and therefore are cited under 35 USC § 102(a). Moreover, Stuart L. Schreiber, one of the inventors on the current application, is also an author on each of the cited references. The Blackwell *et al.* reference demonstrates that chemistries used to encode a small molecule library prepared on a high-capacity polystyrene support could successfully be decoded. The Clemons *et al.* reference describes a high-throughput method for converting high-capacity beads into arrayed stock solutions. Thus, neither of these references relates to the claimed compounds *per se*.

In order for a reference to qualify as prior art under 35 USC § 102(a), it must be known or used both *by another*, or described in a printed publication . . . *prior to the invention* by the applicant. Even if either the Blackwell *et al.* or the Clemons *et al.* reference could be said to describe (in accordance with the requirements of the patent statutes) one or more of the claimed compounds, such description cannot reflect use *by another* and cannot be *prior to* the invention by Dr. Schreiber, as he is both a named author and a named inventor.

Applicant reserves the right to submit a Declaration explaining that none of the authors other than Dr. Stuart L. Schreiber who are listed on the Blackwell *et al.* or Clemson *et al* papers

contributed to the conception of the compounds claimed in the present application. Accordingly, neither of these references is proper prior art and all rejections based on them should be removed.

CONCLUSION

Based on the Remarks presented above, Applicant submits that the claims, as amended herein, are allowable over the art of record. The claims are fully supported by the specification and the amendments presented in the present paper do not present new matter. The patent should issue. A Notice to that effect is respectfully requested.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required for consideration of this paper (including fees for net addition of claims) are authorized to be charged to our Deposit Account No. 03-1721.

Respectfully submitted

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